

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-4 are rejected under 35 U.S.C. 102(b) over the patent to Carcey and also under 35 U.S.C. 112, and the drawings are objected to.

In connection with the Examiner's formal objections to the drawings, applicant has submitted a copy of the drawings with the proposed corrections. It is believed that the Examiner's grounds for the objection to the drawings should be considered as no longer tenable.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, and under 35 U.S.C. 112, applicant has cancelled the original claims and submitted three new independent claims 5, 6 and 7.

It is respectfully submitted that the new features of the present invention as defined in these claims clearly and patentably distinguish the present invention from the prior art.

Before the analysis of the prior art it is believed to be advisable to explain to the Examiner the subject matter of the present invention and the new features which are defined in the claims.

Claim 5 specifically defines a dust withdrawing arrangement in which the passage means for withdrawing dust from the inner space of the individual enclosures is formed as a gap 8 which includes two portions 9 each communicating with the inner space of a respective one of the two neighboring individual enclosures, and a joint passage 10 which is connected with the portions 9 of the two neighboring individual enclosures and also is connected with the interior of the common enclosure 2, so that air with dust passes from the two neighboring individual enclosures 7 and 7' first through the portions 9 and then through the joint passage 10 of the gap 8 into the interior of the common enclosure.

Turning now to the reference and in particular to the patent to Carcey, it can be seen, that as indicated by the Examiner, the dust collecting installation of this reference is used for work stations 33, from each work station 33 a feeder pipe 32 is extended, a common enclosure is arranged around the individual enclosures, and there is a common passage 25. While definitely Carcey discloses the above mentioned features, it does not disclose the new features of the present invention as defined in claim 5. The passage means of the Carcey installation do not

include gaps associated with two neighboring individual enclosures and including a portion extending into a space of each one of the two neighboring individual enclosures and then a joint passage formed between the two neighboring individual enclosures and connecting the two portions of the two neighboring individual enclosures with the interior of the common enclosure.

Thus, it is believed to be clear that the new features of the present invention which are now defined in claim 5 are not disclosed in this reference.

Claim 6 defines that at least one of the individual enclosures is arranged relative to the common enclosure so that a space is formed between the at least one individual enclosure and the common enclosure, and the passage means include a gap 8' communicating with the inner space of the at least one individual enclosure and with the space between the at least one individual enclosure and the common enclosure, which space in turn communicates with the interior of the common enclosure, as shown at the right side of Figure 1 of the present application.

While the patent to Carcey shows the dust collecting installation which includes the features specified by the Examiner, it does

not include the new features of the present invention which are now defined in claim 6.

Claim 7 combines the features of claims 5 and 6 and defines the dust withdrawing arrangement with the passage means formed as in the center of Figure 1 (and defined in claim 5) and also formed as shown at the right side of Figure 1 (as defined in claim 6), between the two neighboring individual enclosures, and also between one individual enclosure and the common enclosure. The patent to Carcey does not teach these new features of the present invention.

The original claims were rejected over the patent to Carcey under 35 U.S.C. 102 as anticipated. This reference does not disclose the new features of the present invention as defined in claims 5, 6 and 7. In connection with the anticipation rejection applicant feels that the following citation will be appropriate. As stated in *Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984):

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the reference does not disclose all elements as defined in claims 5, 6 and 7 in their specific order, and also in their interaction and interjunction.

It is therefore believed that the anticipation rejection should be considered as no longer tenable and should be withdrawn.

It is also respectfully submitted that the present invention can not be considered as obvious from this reference. In order to arrive at the applicant's invention from the teaching of this reference, the reference has to be fundamentally modified, in particular by including into it the features which were first proposed by the applicant and defined in claims 5, 6, 7. However, It is known that in order to arrive at a claimed invention, by modifying the references cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggestion; it is not a proper use of a patent as a reference to modify its structural to one which prior art references do not suggest.

Definitely, the reference does not contain any hint or suggestion for such modifications.

It is respectfully submitted that the present invention as defined in claims 5, 6 and 7 provides for highly advantageous results. These highly advantageous results first of all were explained in the "Background of the Invention" section of the present application. Also, when compared with the installation disclosed in the patent to Cacey, it can be seen that the dust withdrawing arrangement of the present invention does not need special pipes for withdrawing dust from the corresponding workstations, but instead the passages are formed substantially between the walls of the individual enclosures, and also between the walls of the individual enclosures and the walls of the common enclosure, so that the construction of the arrangement is simplified. These highly advantageous results can not be accomplished by the construction disclosed in the reference. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case Ex parte Tanaka, Marushima and Takahashi (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that claims 5, 6 and 7 should be considered as patentably distinguishing over the art and should be allowed.

The same is true with respect to claims 8, 9 and 10 which are even more specific.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-243-3818).

Extension Request

*Please extend the term
for response by
month and charge
to 26-0085*

Respectfully submitted,

[Signature]
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